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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,914	09/22/2004	Jean-Marie Bourreau	04129	7560
23338 7590 10/16/2008 DENNISON, SCHULTZ & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314				
EXAMINER				
SMALLEY, JAMES N				
ART UNIT		PAPER NUMBER		
3781				
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10/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/501,914

**Applicant(s)**

BOURREAU ET AL.

**Examiner**

JAMES N. SMALLEY

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 17-19, 21-23, 26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Naim et al. US 5,101,993.

Naim '993 teaches a functional insert (24) formed of plastic for a plastic container including a flexible rib (104, 106) on an exterior surface (Examiner notes that although the surface on which the ribs are disposed is surrounded by walls (28b and 37a) the ribs are still on a surface which is exposed to ambient and are thus read to be on an "external surface".), and a permanent adhesive (100) applied over the ribs and which is taught in column 4, lines 37-45 to be "...viscous or pliant when applied, and may be any conventional product which is capable of sealing plastics together, including, but not limited to, thermoplastic-type hot melt adhesives composed of polymers such as polyamides, polyesters, ethylene-vinyl acetate copolymers, and polyethylene. If a solvent is employed, it will be of the type which slightly dissolves adjacent surfaces to form a strong bond." Examiner notes regarding claim 7 that an activator is inherently present, as such a substance is what reacts to heat in order to adhere the elements to each other.

Examiner notes that while the adhesive may be applied to the container, it still comes in contact with the ribs. Regardless, the limitation is a method step within the scope of an apparatus claim, and patentability is only determined by the final product. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is

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unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton GB 2,244,691 in view of Nairn et al. US 5,101,993.

Hamilton '691 as applied teaches all limitations substantially as claimed including an anti-fraud device applied to the neck of a bottle and fixed by a bonding adhesive (34) but fails to teach a permanent adhesive (100) applied over the ribs.

Nairn '993 teaches applying an adhesive to ribs of a container attachment.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the anti-fraud cap of Hamilton '691, providing the adhesive along the ribs as taught by Nairn '993, motivated by the benefit providing a secure fast connection between the two elements. Furthermore, it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

5. Claim 20 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Nairn et al. US 5,101,993 applied above under 35 U.S.C. 102(b).

Regarding claim 20, Nairn '993 as applied above under 35 U.S.C. 102(b) teaches all limitations substantially as claimed but fails to teach a) the adhesive being applied in 1-4 discontinuous deposits.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the placement of the adhesive of Nairn '993, providing anywhere from 1-4 discontinuous

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deposits, motivated by the benefit of providing sufficient space for the deposits to spread out when the fitment is pressed onto the container neck. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Regarding claim 25, Nairn '993 fails to teach the contact area being between 20 and 500 mm<sup>2</sup>, and the force of the adhesive being strong enough to withstand an axial force of 0.5 daN.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the area of the adhesive contact to between 20 and 500 mm<sup>2</sup> or to any other sufficient area, motivated by the benefit of providing sufficient force to withstand an axial forcing of 0.5 daN, or any other required force, in order to maintain the fitment securely on the container neck. Examiner notes a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Furthermore, it has been held that discovering an optimum value of a result-effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nairn et al. US 5,101,993 applied above under 35 U.S.C. 102(b), in view of Delgado US 5,045,569.

Nairn '993 as applied above teaches all limitations substantially as claimed, but fails to teach the adhesive being formed of micro-balls that release the adhesive. However, the reference does teach that many different types of adhesives are suitable, in column 4 lines 37-45, including those formed of polymers.

Delgado '569 teaches hollow acrylate polymer microspheres, disclosing in the abstract that the invention provides "pressure-sensitive adhesives".

It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ pressure sensitive adhesive in the form of a polymer including micro-balls, as taught by Delgado '569 and as taught to be suitable for use with the invention by Nairn '993, motivated by the benefit of manufacturing the invention with one less step (that being the heat-activation step) which

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makes the overall process more efficient. Furthermore, Examiner notes it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

7. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nairn et al. US 5,101,993 applied above under 35 U.S.C. 102(b), in view of Fuchs US 5,078,288.

Nairn '993 as applied above teaches all limitations substantially as claimed, but fails to teach a shell reversible fixing means including reversible click fitting.

Fuchs '288 teaches a child-resistant closure comprising click fitting elements (23, 24) which prevent access to the container by a child, but which can be removed by an adult by compressing the container neck at diametric points.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cap of Nairn '993, providing the reversible click-fitting means of Fuchs '288, motivated by the benefit of providing child-resistant means to the container.

Regarding claim 30, the cap and container of Nairn '993 are taught to be formed of plastic.

Regarding claim 31, wall (36a/b/c) of Nairn '993 will separate the closure cap skirt (50) from contacting the adhesive.

#### ***Response to Arguments***

8. Applicant's arguments filed June 27, 2008 have been fully considered but they are not persuasive.

**Applicant argues Nairn '993 fails to teach a cylindrical wall supporting the ribs.**

Examiner notes the wall (36c) comprises a cylinder, as it is annular, and has an axial thickness.

**Applicant argues the ribs of Nairn '993 will not curl upwardly.**

Examiner notes the ribs are resilient plastic, and, triangular in cross-section. They thus will inherently curl at the tip in either direction as the insert is pressed onto the container. Secondly, the

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direction is not relevant as the container and insert could be manufactured sideways, and thus a left or right curl would thus become up or down.

**Applicant argues the ribs of Nairn '993 do not support the adhesive.**

Examiner notes that while the adhesive may be applied to the container, it still comes in contact with the ribs. Regardless, the limitation is a method step within the scope of an apparatus claim, and patentability is only determined by the final product. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James N Smalley/  
Examiner, Art Unit 3781

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